

### **REMARKS**

[0001] Claims 1-32, 38, 39, and 41-45 are pending. Claim 6 is rejected as being indefinite under 35 U.S.C. § 112. Claims 1, 2, 4-10, 12-18, 20-26, 28-32, 38-39, and 45 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yanaka, et al., U.S. Patent No. 6,467,034 (hereinafter “Yanaka”). Claims 3, 11, 19, and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yanaka in view of Yamagami, U.S. Patent Publication No. 2002/0143999 (hereinafter “Yamagami”). Claims 41-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yanaka in view of the IBM Global Services article entitled “Leveraging New Storage Technology for A Competitive Advantage” (hereinafter “IBM”). Claim 44 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yanaka in view of Applicant’s admitted prior art (hereinafter “AAPR”).

### **AMENDMENTS TO THE CLAIMS**

[0002] Claims 1, 6, 9, 17, 25, and 38 have been amended to more particularly point out the features of the present invention. The amendments are fully supported by the specification, drawings, and claims. No additional claims have been cancelled. No new claims have been added. No new matter has been added.

### **REJECTION OF CLAIMS 1-16, 21-24, 29-32 AND 40 UNDER 35 U.S.C. § 112**

[0003] Claim 6 is rejected as being indefinite under 35 U.S.C. § 112. The Office Action states that the phrase “differences between the copy function attributes and the predefined copy policy attributes are the smallest” renders the claim indefinite, because one of skill in the art would be unable to determine what constitutes the smallest difference between a copy function attribute and the predefined copy policy attributes. Thus Applicants have amended Claim 6 to now recite “difference between the numerical values of the copy function attributes and the numerical values of the predefined copy policy attributes is the smallest” to specify that differences refer to the difference between numerical values assigned to the copy function attributes and those assigned to copy policy attributes. Applicants submit that the amendments to

Claim 6 are sufficient to overcome the § 112 rejection of Claim 6 and request that the rejection be withdrawn.

REJECTIONS UNDER 35 U.S.C. §102(b)

[0004] The Office Action rejected Claims 1, 2, 4-10, 12-18, 20-26, 28-32, 38-39, and 45 under 35 U.S.C. §102(b) as being anticipated by Yanaka. The Applicants respectfully traverse this rejection. “Anticipation under 35 U.S.C. §102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. ... Whether such art is anticipating is a question of fact.” *Apple Computer, Inc. v. Articulate Systems, Inc.* 234 F.3d 14, 20, 57 USPQ2d 1057, 1061 (Fed. Cir. 2000). It is well settled that under 35 U.S.C. §102 “an invention is anticipated if . . . all the claim limitations [are] shown in a single art prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim.” *Richardson v. Suzuki Motor Co., Ltd.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). In determining whether a prior art reference anticipates a claim, it is necessary to (1) determine the scope of Applicant's broadest claim, (2) determine exactly what the single prior art reference discloses, and (3) compare each and every claim limitation against the prior art disclosure. *SSIH Equipment, S.A. v. U.S Int'l Trade Commission et al.*, 218 U.S.P.Q. 678, 688. Only if each limitation is literally disclosed by the prior art reference is the claim anticipated.

[0005] With regard to Claim 1, the Office Action states that Yanaka discloses: “compare[ing] one or more attributes of each available copy function to corresponding attributes of a predefined copy policy” stating that “the write activity detector monitors the write requests and identifies if the present mode (i.e. synchronous, semi-synchronous or adaptive – the three predefined copy policies) is appropriate for the data transfer” and cites column 7, lines 20-32 of Yanaka as evidence. Office Action at p.6.

[0006] The Applicants have amended Claim 1 to recite “wherein the copy policy comprises a set of copy policy attributes that correspond to the copy function attributes of each copy function, wherein the copy function attributes comprise predefined values that indicate

functionality characteristics of the corresponding copy function.” Applicants submit that such an amendment further distinguishes Claim 1 from Yanaka, because Yanaka fails to teach a copy policy that comprises a set of copy policy attributes that **correspond** to copy function attributes of each copy function. Further, Yanaka fails to teach copy function attributes that comprise **predefined values that indicate functionality characteristics of the** copy functions.

[0007] Yanaka teaches that the write activity detector “monitors **activity** of a command received by the host controller A121, and when it recognizes that the activity has become larger than the range of an activity estimated in an operation mode at that point in time, it issues a signal to change over the mode to a mode making it possible to perform a data processing at a higher speed through the host controller A121.” Yanaka at col. 7, ll. 25-32. Applicants maintain the assertion that monitoring **activity** is not the same as comparing **attributes** of copy policy with attributes of a copy function that include predefined values. Activity relates to execution speed of a data copy request and amount of delay of unexecuted requests. Further, Applicants submit that Yanaka appears to be silent with regard to a predefined copy policy that includes copy policy attributes that correspond to predefined copy function attributes.

[0008] This concept is made clear as the write activity detector is further defined in Yanaka in column 9, lines 8-67. Yanaka teaches using predefined queue trigger points to change from one predefined copy mode to another. *Id.* at col. 9, ll. 8-67. Yanaka does not compare attributes with attributes, but instead compares performance metrics to predefined limits to shift from one copy mode to another. Even if a predefined limit of Yanaka is incorrectly assumed to be a predefined copy policy attribute, it is not compared to an attribute of a copy function comprising a predefined value, but instead is compared to performance metrics measured within a processor or related hardware.

[0009] The invention of amended Claim 1 recites that attributes of a copy function are compared to corresponding attributes in a predefined copy policy. This is a comparison of an attribute with a similar attribute, not a performance metric compared to a limit. The Applicants respectfully assert that Yanaka does not anticipate amended Claim 1 because Yanaka does not

teach, disclose, or suggest comparing an attribute of a copy function with a predefined copy policy attribute.

[0010] The Office Action states that Yanaka discloses “a selection module configured to automatically select a copy function that satisfies the predefined copy policy” and states that “the write activity issues a command to change the remote copy mode to another predefined mode that is most appropriate for the transfer” and cites column 7, lines 25-36 and column 5, line 71 through column 6, line 11 of Yanaka as evidence. Office Action at p. 6.

[0011] Applicants have amended Claim 1 to now recite “a selection module configured to automatically select a copy function that satisfies the predefined copy policy based on the comparison of the copy function attributes to the corresponding attribute objectives of the copy policy.” Applicants respectfully submit that Yanaka fails to teach automatically selecting a copy function that satisfies a predefined copy policy **based on a comparison of attributes** as now recited in Claim 1.

[0012] Thus, in order to move along prosecution, the Applicants have amended functions of the identification module in the first element of Claim 1 to further clarify that Yanaka does not teach, disclose, or suggest the limitations associated with the identification module. Specifically, amended Claim 1 recites that each **identified** copy function is compatible with the secondary storage device where the data copy request directs the data and is available to the an application to copy data to the secondary storage device. Yanaka does not teach selecting a copy function from copy functions compatible with a storage device and also available to an application. The Applicants respectfully assert that Yanaka fails to teach, disclose, or suggest all of the limitations of amended Claim 1 and that amended Claim 1 is in condition for immediate allowance.

[0013] The Applicants respectfully assert that Claims 9, 17, 25, and 38 as amended are similar in scope to Claim 1 and that the arguments presented above for Claim 1 are equally applicable and therefore Claims 9, 17, 25, and 38 are allowable. Applicants note that in the interest of expediting prosecution, Claim 9 has been amended to recite that the copy function attributes comprise “predefined **numerical** values.” Applicants submit that this additional amendment further distinguishes Claim 9 from the prior art.

[0014] In addition, the Applicants assert that Claims 2, 4-8, 10, 12-16, 18, 20-24, 26, 28-32, 39, and 45 are allowable because they depend from allowable claims.

REJECTION OF CLAIMS 3, 11, 19, AND 27 UNDER 35 U.S.C. §103(a)

[0015] The Office Action rejected Claims 3, 11, 19, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Yanaka in view of Yamagami. The Applicants respectfully traverse this rejection. The Applicants respectfully assert that Claims 1, 9, 17, and 25 are in condition for allowance. Claims 3, 11, 19, and 27 depend on Claims 1, 9, 17, and 25 and because the invention of Claims 1, 9, 17, and 25 are allowable, the Applicants respectfully assert that Claims 3, 11, 19, and 27 are similarly in condition for allowance because they depend from allowable claims. A similar argument applies to Claims 41-44 and those claims are allowable for the same reasons.

[0016] Should additional information be required, the Examiner is respectfully asked to notify the Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

/Brian C. Kunzler/

Bruce R. Needham  
Reg. No. 38,527  
Attorney for Applicants

Date: February 10, 2009  
8 East Broadway, Suite 600  
Salt Lake City, UT 84111  
Telephone (801) 994-4646  
Fax (801) 531-1929